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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,127	09/24/2003	Kraig A. Kirschner	7234-116/10310907	2535

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FULBRIGHT AND JAWORSKI L L P  
PATENT DOCKETING 29TH FLOOR  
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LOS ANGELES, CA 900172576

EXAMINER

KING, ANITA M

ART UNIT PAPER NUMBER

3632

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/670,127

Applicant(s)

KIRSCHNER, KRAIG A.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-17, 19-23 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 18 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is the second office action for application number 10/670,127, Fire Sprinkler Mount, filed on September 24, 2003.

***Claim Rejections - 35 USC § 112***

Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26-28 recite the limitation "the extension" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12, 13, 15-17, 19-23, and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,224,682 to Baughman. Baughman discloses a mount (10) capable of supporting a fire sprinkler, comprising: a base (12) including a support, a first arm (65) extending from the support, a second arm (38) extending from the support and displaced from the first arm and a guide (66), the first arm having a first support hole (67) through the first arm and the second arm having a second hole (50) through the second arm and aligned with the first support hole; a bracket (27) including a first end, a second end, a retaining hole (34) adjacent the first end, a mounting hole (in element 62) adjacent the second end and a follower (64) engaging the guide, the

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first end extending from the second end away from the base; a threaded rod (42) extending through the first support hole, the second support hole and the mounting hole and adjustable mounting the bracket parallel with the alignment of the first and second support holes and restraining the bracket from moving laterally of the alignment of the first and second support holes, the engagement of the guide and the follower restraining the bracket from moving rotationally about the rod; the mounting hole being threaded (Col. 6, line 65ff) on the threaded rod, the threaded rod including rod ends with shoulders (@44 & 46) not extendible through the first and second support holes; the first arm and the second arm being parallel to one another at the first support hole and the second support hole; the guide being a surface on the support, facing and parallel to the threaded rod; the support having a body (36) and attachment wings (opposing sides of slot 20 of element 12) extending to either side of the body and lying in a first plane, the body lying in a second plane parallel to and displaced from the first plane; and the base including fasteners (Col. 5, line 19ff) on a first side of the base facing away from the extension of the first end away from the base.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baughman in view of U.S. Patent 5,829,718 to Smith. Baughman teaches, substantially, each feature of the claimed invention as discussed above. Baughman

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does not teach a nut on one of the rod ends. Smith, however, teaches a nut on a rod end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Baughman's rod end 44 to have included a nut at the end of the rod as taught by Smith, between the cotter pin (52) and horizontal member (38) in order to sustain any upward load on the threaded rod (42) that might break the cotter pin (52) and to reduce the shear stress on the cotter pin.

### ***Allowable Subject Matter***

Claims 18 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

In response to applicant's argument that Baughman describes a device for a drill, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the device in Baughman cannot provide an extended support to accommodate a sprinkler mounting relative to a suspended ceiling, the element 24 in Baughman is capable of being attached to a suspended ceiling and a fire sprinkler can be supported within the retaining hole designated in the office action. Also, the retaining hole does extend away and beyond the second arm in the horizontal direction.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday. Note starting April 8, 2005 the examiner may be reached at (571) 272-6817.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156 and after April 8, 2005 can be reached on (571) 272-6815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anita M. King  
Primary Examiner  
Art Unit 3632

April 3, 2005